REMARKS

Summary of the Final Office Action

Claims 1 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki et al. (U.S. Patent No. 6,735,699 B1) (hereinafter "Sasaki") in view of Van Huben et al. (U.S. Patent No. 6,327,594) (hereinafter "Van Huben").

Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki in view of Van Huben and further in view of Stallings (hereinafter "Stallings").

Claims 4 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolfe (hereinafter "Wolfe") in view of Sasaki and Van Huben.

Claims 5, 6, 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolfe in view of Sasaki and Van Huben and further in view of Stallings.

Summary of the Response to the Office Action

Applicant has canceled claims 1-10 without prejudice or disclaimer and has added new claims 11-15 to differently describe embodiments of the disclosure of the instant application's specification. Accordingly, claims 11-15 are currently pending for consideration.

Rejections under 35 U.S.C. §§ 102(e) and 103(a)

Claims 1 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki in view of Van Huben. Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki in view of Van Huben and further in view of Stallings. Claims 4 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolfe in view of Sasaki and

Van Huben. Claims 5, 6, 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolfe in view of Sasaki and Van Huben and further in view of Stallings. Applicant has canceled claims 1-10 without prejudice or disclaimer, rendering the rejections of these claims moot. In addition, Applicant has added new claims 11-15 to differently describe embodiments of the disclosure of the instant application's specification. To the extent that these rejections might be deemed to apply to the newly-presented claims 11-15, they are respectfully traversed for at least the following reasons.

Applicant has presented a new independent claim 11 that describes a novel combination of features of a "user device." In the Office Action, the Examiner asserts that "user A" in Sasaki (Fig. 1) allegedly corresponds to the "storage in a storage server" features of previous claims 1 and 10 of the instant application. Applicant respectfully submits that Sasaki discloses, at col. 6, lines 1-15, that

> **Another user B** has a user device or recording and reproducing unit 16B like the user A, in which an encoder 18B including an identification code ID(B) of the user B is incorporated. If the user B makes a copy of the digital work 12 from the user A, it is taken into the user device 16B as a digital work 12B (Step (7)). The encoder 18B of the users code ID(B) sends a work identification code of the digital work 12B and a device identification code ID(B) of the user B to the DRC 20 to apply a permission (Step (8)). **The DRC 20 checks that the user B is permitted to use the digital work 12B by collating the identification codes (work code and device ID(B)) with data in the rights registration database 14**

(Step (4)). If it is found that his or her utilization permission is registered, **the DRC 20 sends a grant instruction of the license 22B to the user B** (Step (9)) (emphasis added).

Accordingly, Applicant respectfully submits that if "user A" corresponds to "storage server" in embodiments of the instant application, it can be inferred that the Examiner understands that "DRC 20" in Sasaki corresponds to the "host-function device," and "user B" in Sasaki corresponds to "user device" of embodiments of the instant application.

However, Applicant respectfully submits that in the newly-presented claims 11-15, the "user device" feature of the claims communicates only with "storage" and not with the "host-function device" after the digital information is sent to "storage." On the contrary, Applicant notes that it is clearly disclosed in Sasaki that

> **The DRC 20 checks that the user B is permitted to use the digital work 12B by collating the identification codes (work code and device ID(B)) with data in the rights registration database 14** (Step (4)). If it is found that his or her utilization permission is registered, **the DRC 20 sends a grant instruction of the license 22B to the user B** (Step (9)) (emphasis added).

In embodiments of the disclosure of the instant application, Applicant respectfully submits that once "digital information" is sent and held in the storage exclusively for a user, permission or grant between the "storage"(user A) and the "host-function device"(DRC 20) does not occur,

because input and output to the user device (user B) are controlled by the storage server after the data is obtained from the storage server (user A). According to Sasaki, Applicant respectfully submits that there is no disclosure that "user A" has such a control function to any extent.

Even further, Applicant respectfully submits that the expression "Another user B" in the above-presented quotation means that "user A" and "user B" are different, or separate and distinct, entities that have no mutual relation to each other. In embodiments of the disclosure of the instant application, on the other hand, the storage provided exclusively for the user is equipped in the storage server. The storage is for the user of the user device. Therefore, "user B," which is other than "user A," can never correspond to the storage exclusively for the user.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that the Sasaki reference should now be withdrawn as not being relevant for inclusion as part of a 35 U.S.C. § 103 rejection against the newly-presented claims.

With regard to Van Huben, Applicant respectfully submits that the disclosed structure differs from that of embodiments of the disclosure of the instant application, as described in the newly-presented claims. For example, in embodiments of the disclosure of the instant application, an order of distributing digital information is transmitted from a user device to an information distribution server, and the ordered digital information is stored into a storage exclusive for a user of the user device. The user device is provided to be able to access the information distribution server and the storage.

However, Applicant respectfully submits that Van Huben does not teach, or even suggest, such a structure. In particular, while Fig. 12B of Van Huben illustrates a server 310 and a data server 312, there is no structure corresponding to any of: a user device, a storage server

having a storage exclusively for a user, and a network connected to the storage, in the manner described in the newly-presented claims of the instant application. Applicant respectfully submits that the workstation 314 obviously does not correspond to either the user device or the storage features of the instant application's newly-presented claims. Even further, there is no disclosure with regard to duplicate-time limit information. Therefore, Applicant respectfully submits that the natures of check-in and check-out without control of duplicate-time limit information are significantly different from the above-discussed features of embodiments of the disclosure of the instant application, as described in the newly-presented claims.

Accordingly, Applicant respectfully asserts that the rejections under 35 U.S.C. § 103(a) should be withdrawn because neither of Sasaki and Van Huben, whether taken separately or in combination, teaches or suggests each feature of newly-presented independent claim 11 and neither Sasaki, Wolfe, nor Van Huben, whether taken singly or combined, teach or suggest each feature of newly-presented independent claim 11.

MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, Applicant respectfully asserts that the dependent claims are allowable at least because of their dependence from claim 11, and the reasons set forth above. Moreover, Applicant respectfully submits that the additionally applied reference to Stallings does not cure the deficiencies discussed above with regard to Sasaki, Van Huben, and Wolfe.

CONCLUSION

In view of the foregoing, Applicant respectfully requests the entry of the Amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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